

## REMARKS

In the first Office Action mailed August 25, 2004, the Examiner rejected original claims 1, 2, 4, 6-8, 11, 13 and 20 under 35 USC 102(b) as being anticipated by Inoue (US 5,136,665), rejected original claims 3 and 12 under 35 USC 103(a) as being unpatentable over Inoue in view of Nierit et al (US 5,414,460), rejected original claims 5 and 10 under 35 USC 103(a) as being unpatentable over Inoue in view of Murray et al (US 6,101,000), rejected original claim 9 under 35 USC 103(a) as being unpatentable over Inoue in view of Masarik (US 5,525,922), and rejected original claims 14-19 under 35 USC 103(a) as being unpatentable over Inoue in view of Hiramatsu et al (US 5,136,665). Moreover, the Examiner objected to original claims 21-25 as being dependent upon rejected base claim 13, and indicated that such claims include allowable subject matter.

A new title of the invention is provided as requested by the Examiner.

Applicant respectfully requests reconsideration in view of the foregoing amendments and the remarks hereinbelow.

### *Inoue does not anticipate Claims 1 and 7.*

Inoue discloses a two-sided original reading apparatus for reading an original from both faces simultaneously. This is done instead of first reading the front face, and then turning the original upside down and reading the rear face.

Differences between the claimed invention and Inoue include the following.

1. Different image information is read from the front and rear faces of the original by reflecting light simultaneously from both of the faces to front and rear photo-electric conversion circuits 18 and 25. No light is passed through the original as in Claims 1 and 7. This was incorrectly assumed by the Examiner in paragraph no. 3 (Page 2) of the rejection.

2. The original in Inoue is not a film as in claims 1 and 7 since it has different image information on opposite sides and is opaque. Inoue is concerned with reading different image information from both sides of an opaque file medium such as an optical or magnetic disc (not a film through which light

can be passed). A film does not have different image information on its opposite sides and generally is non-opaque.

3. Although in paragraph no. 3 (Page 2) of the rejection the Examiner points to col. 1, lines 14-33, and col. 4, lines 3-35, in Inoue as disclosing that the front and rear photo-electric circuits 18 and 25 are coupled to the light sources 13 and 20 to adjust the output of the light sources, there is no such disclosure in Inoue. The front and rear photo-electric circuits 18 and 25 are not coupled to the light sources 13 and 20 as can be seen in FIG. 3; nor do they adjust the output of the light sources. The front and rear photo-electric circuits 18 and 25 serve only to read image information from both sides of an original.

Inoue does not anticipate Claims 4 and 11.

In Inoue there is no disclosure of a first amount of light being reflected from at least one unexposed region of a film and a second amount of light being passed through the at least one unexposed region of the film as in claims 4 and 11. This was incorrectly assumed by the Examiner in paragraph no. 3. (Page 3) of the rejection. The original in Inoue does not have unexposed film regions; nor is light passed through such regions. Inoue is concerned with reading different image information from both sides of an opaque file medium such as an optical or magnetic disc (not a film through which light can be passed).

Inoue does not anticipate Claim 13.

In Inoue there is no disclosure of a system for developing and processing film as in claim 13. For example, Inoue does not disclose an applicator operable to coat a processing solution onto the film to initiate development of the film as in claim 13. The Examiner in regard to the rejection of claims 5 and 10 acknowledges this by stating that Inoue does not disclose applying a developing chemical to a film. Thus, the Examiner appears to have incorrectly included claim 13 in paragraph no. 3 (Page 2) of the rejection.

Inoue does not anticipate Claim 20.

In Inoue there is no processing circuitry that operates to vary the intensity of light illuminating a coated film to substantially prevent saturation of a sensor as in claim 20. The Examiner in paragraph no. 3 (page 3) of the rejection points to

col. 4, lines 3-35, in Inoue. However, col. 4, lines 3-35, provides no such disclosure. If the Examiner continues this rejection, a clarifying explanation is requested so that any difference of opinion can be better addressed.

*Claims 3 and 12 (and) 13 are non-obvious over Inoue in view of Nierit et al.*

Nierit et al discloses a film scanner having an aperture defining mechanism 33 including blades 35 and 37 that can be adjusted to vary the diameter of a circular aperture to shape a light beam to modulate its level, in order to compensate for film type.

There is no motivation, whatsoever, for a person of ordinary skill in the art to change the two-sided original reading apparatus in Inoue by adding the aperture defining mechanism 33 to the two-sided original reading apparatus. The two-sided original reading apparatus in Inoue is not intended to read photographic film and therefore has no reason to compensate for film type as in Nierit et al. The Examiner assuming that the motivation arises simply because Inoue and Nierit et al relate to scanners is an insufficient basis for establishing the required *prima facie* case of obviousness., and instead is an impermissible hindsight reconstruction of the claimed invention.

Moreover, the aperture defining mechanism 33 in Nierit et al is not "processing circuitry" as in the claimed invention.

*Claims 5 and 10 (and 13) are non-obvious over Inoue in view of Murray et al.*

The Examiner acknowledges that Inoue does not disclose applying a developing chemical to a film.

Murray discloses a photographic processing method including applying a chemical developer to a film.

There is no motivation, whatsoever, for a person of ordinary skill in the art to change the two-sided original reading apparatus in Inoue by adding a photographic processing method including applying a chemical developer to a film. The Examiner asserts the motivation to do this arises simply because both involve "a process carrying media". This is an insufficient basis for establishing the required *prima facie* case of obviousness., and instead is an impermissible

hindsight reconstruction of the claimed invention. Inoue is concerned with reading different image information from both sides of an opaque file medium such as an optical or magnetic disc. The two-sided original reading apparatus in Inoue is not intended to read a photographic film as in the claimed invention. Thus, a person of ordinary skill in the art would find any prior art basis to add film processing to the two-sided original reading apparatus in Inoue.

*Claims 14-19 non-obvious over Inoue in view of Haramatsu et al.  
Hiramatsu et al.*

Hirmatsu et al discloses a film scanner for a scanning a photographic film through which light can pass; not a scanner of both sides of an original that is opaque, so that light cannot pass through it as in Inoue. Thus, there is no motivation for a person of ordinary skill in the art to combine these references as the Examiner has done in paragraph no. 8 (Page 5 – Page 6) of the rejection.

Moreover, in Hirmatsu et al (although the film scanner has a subscan system 6 arranged to scan the unexposed portion of a film) there is no processing circuitry that operates to vary the intensity of the light in response to a sensor measurement from an unexposed portion of the coated film as in claim 14.

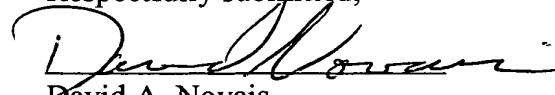
The Amendment-Claims

Original claims 1-20 have not been amended in view of the foregoing remarks.

Original claims 21-25 have been amended to include subject matter indicated by the Examiner to be allowable.

New claims 26-32 further patentably define the invention over the cited references discussed above.

Respectfully submitted,



David A. Novais

Attorney for Applicant(s)

Registration No. 33,324

DAN/lid

Rochester, NY 14650

Telephone: 585-588-2727

Facsimile: 585-477-1148

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.